



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,173	07/12/2001	Jay M. Short	09010-017006	3152

20985 7590 02/25/2003

FISH & RICHARDSON, PC
4350 LA JOLLA VILLAGE DRIVE
SUITE 500
SAN DIEGO, CA 92122

EXAMINER

SLOBODYANSKY, ELIZABETH

ART UNIT	PAPER NUMBER
----------	--------------

1652

DATE MAILED: 02/25/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/905,173

Applicant(s)

SHORT ET AL.

Examiner

Elizabeth Slobodyansky

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-92 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-92 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1652

DETAILED ACTION

Claims 1-92 are pending.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-23, 40-41, 67-85 drawn to DNA, vectors, hosts cells, probes and expression of transaminase, classified in class 435, subclass 193.
- II. Claims 24-35, 64, 86-87 drawn to transaminases, classified in class 435, subclass 193.
- III. Claims 36-39, drawn to transaminase antibodies, classified in class 530, subclass 387.9.
- IV. Claims 42-55, drawn to methods of generating a variant polynucleotide, classified in class 435, subclass 440.
- V. Claims 56-60, drawn to a computer and computer readable medium, classified in class 712, subclass 1.
- VI. Claims 61-63, drawn to methods of computer analysis of polynucleotide sequences, classified in class 700, subclass 90.
- VII. Claim 65, drawn to a method of using a transaminase, classified in class 435, subclass 168.

Art Unit: 1652

VIII. Claim 66, drawn to methods of identifying variant polypeptides, classified in class 435, subclass 27.

IX. Claims 88-92, drawn to a method of modifying small molecules, classified in class 435, subclass 41.

For each of inventions I-IX above, restriction to one of the following is also required under 35 USC 121.

Therefore, election is required of one of inventions I-IX and one of inventions (A)-(J).

(A). SEQ ID No: 17, a sequence encoding thereof, or an antibody against it and methods of making and use thereof .

(B). SEQ ID No: 18, a sequence encoding thereof, or an antibody against it and methods of making and use thereof .

(C). SEQ ID No: 19, a sequence encoding thereof, or an antibody against it and methods of making and use thereof .

(D). SEQ ID No: 20, a sequence encoding thereof, or an antibody against it and methods of making and use thereof .

(E). SEQ ID No: 21, a sequence encoding thereof, or an antibody against it and methods of making and use thereof .

(F). SEQ ID No: 22, a sequence encoding thereof, or an antibody against it and methods of making and use thereof .

(G). SEQ ID No: 23, a sequence encoding thereof, or an antibody against it and methods of making and use thereof .

(H). SEQ ID No: 24, a sequence encoding thereof, or an antibody against it and methods of making and use thereof .

Art Unit: 1652

(I). SEQ ID No: 35, a sequence encoding thereof, or an antibody against it and methods of making and use thereof .

(J). SEQ ID No: 39, a sequence encoding thereof, or an antibody against it and methods of making and use thereof .

The inventions are distinct, each from the other because of the following reasons:

Inventions (A)-(J) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions, represent structurally different polypeptides and the polynucleotides encoding them and antibodies against them. Therefore, where structural identity is required, such as for hybridization or expression, the different sequences have different effects.

The DNA of Group I, and the proteins of Groups II and III, and the computer of Group V each comprise a chemically unrelated structure capable of separate manufacture, use and effect. The DNA comprises a nucleic acid sequence, and the proteins of Groups II and III each comprise unrelated amino acid sequences while the computer is a unrelated article of manufacture. The DNA has other utility besides encoding the proteins such as a hybridization probe, the proteins can be made by another method such as isolation from natural sources or chemical synthesis and the proteins have other utility besides acting as an antigen to induce the antibodies such as for the methods of Group III.

Art Unit: 1652

Inventions I and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the product can be used to induce produce the proteins of Group II.

Inventions II and VII, VIII, or IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the product can be used to induce antibodies.

Inventions V and VI are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process can be practiced by hand.

The proteins of Group II, and the antibody of Group III are unrelated to the method of Group IV as they are neither used nor made by the method of Groups IV.

Art Unit: 1652

The DNA of Group I, and the antibody of Group III are unrelated to the methods of Groups VII, VIII, and IX as they are neither used nor made by the methods of Groups VII, VIII, and IX.

The DNA of Group I, the proteins of Group II, and the antibody of Group III are unrelated to the method of Group VI as they are neither used nor made by the method of Groups VI.

The methods of Groups IV and VI-IX are independent as they comprise different steps, utilize different products and produce different results.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

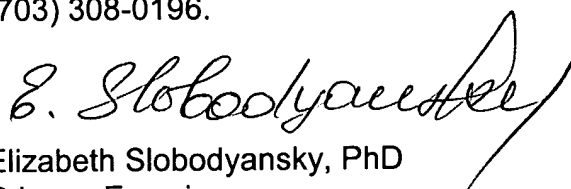
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Art Unit: 1652

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Slobodyansky whose telephone number is (703) 306-3222. The examiner can normally be reached Monday through Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX phone number for Technology Center 1600 is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Center receptionist whose telephone number is (703) 308-0196.


Elizabeth Slobodyansky, PhD
Primary Examiner

February 12, 2003